

### REMARKS

This is a full and timely response to the Office Action mailed July 09, 2008.

By this Amendment, claim 1 has been amended to incorporate the subject matter of claims 2 and 4. Thus, in view of the amendments to claim 1, claim 2 has been canceled without prejudice or disclaimer to its underlying subject matter. Further, claims 4, 9 and 16 have been amended to depend on claim 1. Thus, claims 1 and 3-17 are currently pending in this application. Support for the claim amendments can be readily found variously throughout the specification and the original claims.

In view of these amendments, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

### Rejections under 35 U.S.C. §103

Claims 1-9, 12-14 and 16-17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jeffries et al. (U.S. Patent No. 5,221,050) in view of Coffee et al. (U.S. Patent No. 6,595,208 B1). Further, claims 10-11 and 15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jeffries et al. (U.S. Patent No. 5,221,050) in view of Coffee et al. (U.S. Patent No. 6,595,208 B1), and further in view of Hartle et al. (U.S. Patent No. 5,725,161). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations, and provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Here, in this case, none of the cited references, either alone or in combination, teach or suggest all of the limitations of the claims with particular emphasis on the limitations "*a pump in immediate downstream relation with the reservoir for supplying the liquid composition from the reservoir*", "*wherein the device further comprises a field electrode surrounding the reservoir, said field electrode being connected to said high voltage generator for providing the entire liquid composition with more or less a common electric potential*", "*wherein said device includes a housing carrying said actuator, said high voltage*

*generator, and said power source", "said housing being formed with a concavity for detachably receiving said reservoir", "said field electrode being incorporated in said housing around said concavity", and "said reservoir being coupled to said dispensing unit and is cooperative therewith to define said cartridge".* Also, in view of the teachings of the cited references and the knowledge in the art, one skilled in the art would not have been motivated to combine the teachings of the cited references to arrive at the present invention.

The Examiner states that original claims 1-9, 12-14, and 16-17 are obvious over the teachings of Jeffries et al. (U.S. Patent No. 5,221,050) and Coffee et al. (U.S. Patent No. 6,595,208 B1). In formulating the rejection, the Examiner recognizes that Jeffries et al. does not disclose (1) a dispensing unit comprising (suction) pump in immediately downstream relation with the reservoir for supplying the liquid composition from the reservoir, and (2) a field electrode surrounding the reservoir, and being connected to the high voltage generator for providing the entire liquid composition with more or less a common electrical potential. However, the Examiner has attempted to cure these deficiencies of Jeffries et al. mentioned above by citing the teachings of Coffee et al. However, Applicant strongly disagrees with the Examiner's arguments in this regard since the Applicant believes that one skilled in the art would not be motivated to combine Jeffries et al. and Coffee et al., and that even if the references were combined, such a combination would still not achieve the invention of the claims as now amended.

Jeffries et al. relates to an electrostatic sprayer for dispensing liquid. As described in column 4, line 60, to column 5, line 3, of Jeffries et al., the sprayer is configured to provide a flow of liquid over a certain length of time. In contrast, Coffee et al. relates to a device suitable for delivering comminuted material to the respiratory system with the aid of airflow. As depicted in FIG. 3b of Coffee et al. showing a mass of such comminuted material, and from the specific delivery system in FIG. 6a and FIG. 7 of Coffee et al. suitable for providing a dosage of spray per action of the lever or latch, one skilled in the art understands and can clearly see that the device of Coffee et al. is not for a continuous spray of liquid. There may be very general statements in Coffee et al. that a piezoelectric diaphragm pump coupled to an electrical control circuit may be used for providing a steady flow of liquid to electrohydrodynamic comminution means (see column 2, lines 56-58, of Coffee et al.). However, there is no specific mechanism or structure for such delivery

system described in Coffee et al. The description of column 2, lines 56-58, in Coffee et al. alone would not motivate one skilled in the art to employ the device of Coffee et al. for the purposes of the claimed invention. Thus, although the devices of Jeffries et al. and Coffee et al. are both in the field of electrostatic devices, their purpose and method of delivery are quite distinct from each other. Hence, Applicant believes that there is no motivation for one skilled in the art to combine the elements of the device found in Jeffries et al. and Coffee et al.

Further, based on the Examiner's arguments in the Action, Applicant believes that the Examiner is using hindsight to randomly select and combine the elements of the devices of Jeffries et al. and Coffee et al. In other words, the Examiner is merely listing the elements of the present invention and locating such elements in Jeffries et al. and Coffee et al. without any regard as to whether one skilled in the art would be motivated to combine the elements in Jeffries et al. with the elements in Coffee et al. Under U.S. practice, the Examiner is not permitted to pick and choose which teachings of Coffee et al. to combine with Jeffries et al. Such a construction is improper since the Examiner is relying on Applicant's own disclosure to establish his case of obviousness. Thus, the Examiner's conclusion of obviousness in this case is based on improper hindsight reasoning, Applicant respectfully submits that this rejection cannot be sustained and should be withdrawn.

Moreover, even if the features of Jeffries et al. and Coffee et al. were somehow conveniently combined, Applicant believes that such a combination still does not arrive at the present invention. First, the delivery system of Jeffries et al. relies on physical positive pressure applied to the flexible sachet containing the liquid. Although FIG. 2 of Coffee et al. depicts a chamber in downstream relation with the reservoir, and column 5, lines 16-33, of Coffee et al. suggests a variety of pumps in a very general way, the specific embodiments of FIG. 6a and FIG. 7 of Coffee et al. and the corresponding portions of the specification of Coffee et al. describe pumps that are not in downstream relationship with the reservoir. Hence, even if one skilled in the art were to employ the delivery system of Coffee et al. and apply it to Jeffries et al., one skilled in the art would employ the system of either FIG. 6a and FIG. 7 of Coffee et al. rather than a system that is not even adequately described.

Secondly, Applicant wishes to direct the Examiner's attention to the function of the further electrode 60 in Coffee et al. From FIG. 3a and FIG. 14, and column 14, lines 9-46, of Coffee et al., one skilled in the art understands that the discharge electrode 50 and further electrode 60 would not have a common electrical potential. Rather, further electrode 60 is designed to be connected to a ground to have a different electric potential from discharge electrode for attracting the comminuted material away from the discharge site. In this regard, further electrode 60 of Coffee et al. plays the role, in the present invention, of the personal surface to which the spray is applied. Further, from a physical configuration point of view, the further electrode 60 may surround the discharge electrode 50, but does not surround the reservoir. Furthermore, the further electrode 60 does not provide the function of field electrode of the claimed invention. Thus, for these reasons, Applicant submits that the combined teachings of Jeffries et al. and Coffee et al. still would not allow one skilled in the art to arrive at the present invention.

In addition, for these same reasons, Applicant also believes that one skilled in the art would not be motivated to combine the teachings of Coffee et al. with Jeffries et al. to arrive at the present invention since one skilled in the art would not be motivated to modify Coffee et al. so that the further electrode 60 has a common electrical potential with the discharge electrode 50. As noted above, the further electrode 60 is designed to be connected to a ground to have a different electric potential from discharge electrode for attracting the comminuted material away from the discharge site. If one skilled in the art were to modify the further electrode 60 to have a common electrical potential with the discharge electrode 50, such modification would render the invention of Coffee et al. unsatisfactory for its intended purpose or, at the very least, change the principle of operation of the invention of Coffee et al.

According to Section 2143.01 of the Manual of Patent Examining Procedure, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, for the reasons outlined

above, Applicant submits that there is no suggestion or motivation in Jeffries et al. and Coffee et al. to combine the teachings of the cited references.

Applicant also wishes to note that to further distinguish the present claims from that which is disclosed in Jeffries et al. and Coffee et al., claim 1 has been amended to comprise the following additional features:

1. *the field electrode is incorporated in the housing around the concavity; and*
2. *the reservoir is coupled with the dispensing unit to define the cartridge.*

Since none of these features are disclosed or suggested in Jeffries et al. and Coffee et al., Applicant submit a *prima facie* case of obviousness cannot be established based on the teachings and suggestion of these cited references.

With regard to the rejection of claims 10, 11 and 15 under 35 U.S.C. §103(a) as being obvious over Jeffries et al. and Coffee et al. in view of Hartle et al. (U.S. Patent No. 5,725,161), Applicant believes that the invention of these claims is also not obvious from the combined teachings of these cited references.

Based on Applicant's review, Hartle et al. does not cure the deficiencies of Jeffries et al. and Coffee et al. noted above and thus, would not help one skilled in the art to arrive at the present invention. The device of Hartle et al. is an electrostatic coating system, which may have an overall gun-type structure similar to the device of Jeffries et al. However, Hartle et al. has the reservoir placed outside the device (see FIG. 1 of Hartle et al.). The structure of Coffee et al. and Hartle et al. are also very distinct from each other. One skilled in the art would not know how to employ the features of Hartle et al. to either Jeffries et al. or Coffee et al. Although Hartle et al. discloses that some of the preferred elements suitable for the present device were generally known as being useful for electrostatic devices, such teachings are not sufficient to cure the deficiencies of Jeffries et al. and Coffee et al. noted above. Hence, Applicant believes that the combined teachings of Jeffries et al., Coffee et al. and Hartle et al. does not render the rejected claims *prima facie* obvious.

Thus, withdrawal of these rejections is respectfully requested.

Applicant also notes that claims 3-17 depend directly or indirectly from amended claim 1 and includes all of the features of amended claim 1. Thus, it is respectfully submitted that claims 3-17 are allowable at least for the reasons claim 1 is allowable as well as for the features they recite.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

**Obviousness-Type Double Patenting Rejection**

Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of copending U.S. Patent Application Nos. 10/588,758, 10/588,729 and 10/588,779. Applicant respectfully traverses these rejections. However, in the interest of expediting the prosecution of the present application, Applicant has submitted herewith terminal disclaimers for U.S. Patent Application Nos. 10/588,758, 10/588,729 and 10/588,779 in accordance with U.S. practice. Thus, withdrawal of these rejections is respectfully requested.

### CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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